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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,340	01/27/2004	Ramanuj Goswami	84781ACPK	1044

7590

11/17/2004

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EXAMINER

CHEA, THORL

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/765,340

Applicant(s)

GOSWAMI ET AL.

Examiner

Thorl Chea

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 03192004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

2. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 19, 20 are indefinite as it is unclear with respect to the use of language "effective amount" without providing any purpose or desirable change of the claimed element or compound. Claim 15 is unclear with respect to the antecedent basis for "said dye". Claim 1 contains no dye therein. There is no antecedent basis for "said filter dye" in claim 19 and "said antihalation dye" in claim 20.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over either EP 0308750 (EP'750).

The EP'750 discloses a heat developable material substantially as claimed. See the base precursor on page 11, compound (III-1); exemplified compound on pages 12-22; the composition of the heat developable material on page 28 such as silver halide, reducing agent and organic silver salt on page 28; the dye such as antihalation dyes or pigment on page 30, lines 45-50 and page 33, lines 3-4. See also the process of forming an image on page 44, lines 30-41. The

EP'750 discloses a base precursor having arylsulfonylacetic acid moiety and having similar function except the heterocyclic containing a nitrogen atom and  $>C=O$  group associated therewith. See for instance the compound (III-1) on page 11 wherein "Y" is a monovalent group wherein the aryl group and heterocyclic group are preferred, and each monovalent group may have one or more substituents group such as carbamoyl or sulfamoyl. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to provide a compound having similar functional group associated with a monovalent group such as heterocyclic compound substituted with a carbamoyl group with a reasonable expectation of success. "A prima facie case of obviousness may be made when chemical compounds have very close structural similarity and similar utilities. "An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties." In re Payne, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA 1979). See In re Papesch, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) (discussed in more detail below) and In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1991)."

5. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Fukui et al (US Patent No. 6,368,782), Helland et al (US Patent No. 5,314,795) and Yabuki et al (US Patent No. 4,981,965). Fukui et al discloses a photothermographic material substantially as claimed. See the document as a whole, especially the teaching in column 55, the base precursor compound 11 and filter dye compound 13. Helland discloses a thermal-dye-bleach construction with a compound containing a functional group such as sulfonylacetic acid in association with filter dye. Note to the abstract, and column 9, lines 60-65, column 11, compound in lines 35-50 which is an arylsulfonyl acetic acid wherein the phenyl group substituted with  $Y_k$ . Yabuki discloses a base precursor in the form of a salt of an organic base with carboxylic acid, and may further use in association with compound known to be use in photographic material. Note to the abstract; columns 5-8; the phenyl sulfonylacetic acid in

columns 9-10; and the additive for silver halide photographic material in columns 24-32. Fukui et al, Helland et al and Yabuki may not disclose heterocyclic containing a nitrogen atom and  $>C=O$  group, but the compound has similar functional group and similar utility, and it would have been obvious to the worker of ordinary skill in the art at the time the invention was made to provide a compound having similar functional with similar utility taught in the applied prior art of record with a reasonable expectation of success. "An obviousness rejection based on similarity on chemical structure and function entails the motivation of one skill in the art to make the claimed compound, in expectation that compounds similar in similar structure will have similar properties." In re payne, 606 F.2d 303, 203 USPQ 245, 254 (CCPA 1979).

6. The comparative results shown in the specification disclosure has been considered, but fail to overcome the rejection set forth above since they are irrelevant to the applied prior art of record, and not commensurate with the scope of the claimed invention.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on (571)272-1526. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

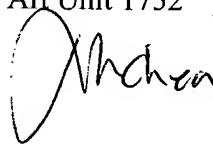
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1700.

tchea *kun*  
November 12, 2004

Thorl Chea  
Primary Examiner  
Art Unit 1752

A handwritten signature in black ink, appearing to read "Thorl Chea", written over the printed name and title.